Office-Supreme Court, U.S.
FILED
MAY 5
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 917

EDWARD A. ZEGERS, d/b/a PRECISION WEATHERSTRIP CO.,

Petitioner,

vs.

ZEGERS, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

THOMAS F. McWILLIAMS
53 West Jackson Boulevard
Chicago 4, Illinois
Attorney for Respondent

The Scheffer Press, Inc.—ANdover 3-6850

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1961

No. 917

EDWARD A. ZEGERS, d/b/a PRECISION WEATHERSTRIP CO.,

Petitioner,

vs.

ZEGERS, INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

This case presents nothing more than the usual suit for patent infringement. It was brought by Respondent, Zegers, Inc., against Petitioner, Edward A. Zegers, who was Sales Manager of Respondent until 1955, when he organized Precision Weatherstrip Co. and entered into competition with Respondent in various products including the subject matter of the patent in suit (299 F.2d 769).

The trial court heard witnesses, examined many documentary exhibits and entered findings of fact and conclusions of law (App. 381-391) and a judgment (App. 391), finding the patent valid and infringed. In the findings of fact, the trial court considered all of the issues presented

to it and held the defenses of Petitioner to be without merit. The Court of Appeals considered all of the defenses urged by Petitioner and affirmed the judgment of the trial court (299 F.2d 769).

No present attack is made on either the finding of validity of the patent or its infringement by Petitioner.

This is the only litigation involving the patent in suit and there is, therefore, no conflict of decisions of Courts of Appeal as to the validity of the patent or its infringement. In its opinion, the Court of Appeals reviewed the fact finding of the trial court and, with respect to each of the issues presented, found that the evidence amply supported the fact findings of the trial court. The Court of Appeals set forth no new rules of law and merely referred to a few of its earlier decisions as guiding it in the determination of the present case. There is no conflict between the decision of the Court of Appeals in this case and other Courts of Appeal concerning any important rule of patent law.

QUESTION 1.

Petitioner suggests by this question that the Court of Appeals determined that the Patent Act of July 19, 1952 has overruled earlier decisions of this Court on the question of patent misuse. Petitioner fails to point to any portion of the opinion of the Court of Appeals which considers this question and an examination of the opinion establishes that the court did not even consider this proposition. The trial court held and the Court of Appeals affirmed the finding that factually, the evidence did not establish any misuse of the patent by Respondent. Under these circumstances it would be most unusual for the court to apply or even consider earlier opinions of this Court on misuse. It did not.

The whole theory of misuse advanced by Petitioner is predicated upon (a) a single letter charging patent infringement sent by Respondent's patent counsel to Petitioner and (b) the alleged false patent marking appearing on the cartons used to package Respondent's products.

(a) With respect to the letter, even in its Petition to this Court, Petitioner concedes that the letter had no effect since Petitioner acknowledges in the Petition (Petition, Page 8), that after receipt of the letter, it continued on with its infringing acts. Relative to the evidence on misuse, the trial court found as a fact (App. 389):

> "As a part of its Counterclaim, Defendant alleges that Plaintiff has been guilty of misusing its patent. Defendant has failed in its burden of proof of establishing any facts in connection with such allegation. The Court finds that Plaintiff has not been guilty of misuse of its patent."

In affirming the trial court on this finding, the Court of Appeals stated (289 F.2d 769, 772):

> "The District Judge found that defendant 'failed to establish any evidence that plaintiff violated the anti-trust laws or otherwise misused its patent. Defendant's counterclaim was accordingly dismissed. Defendant relied principally on a letter sent by plaintiff to defendant which charged that defendant was infringing plaintiff's patent by sales of his 'weatherstrip * * * Seal-Eaz' and his 'modified weatherstrip * * * Aleote.' Defendant's own letters and accompanying literature describing the accused devices show that his 'Seal-Eaz' and 'Aleote' were being promoted for sale with clips."

(b) With respect to the alleged false patent marking which appeared on some of the cartons containing Respondent's products, this matter was thoroughly

presented to the trial court and the following findings were entered (Petition, Appendix Pages 13a, 14a):

"a. That the substance of Defendant's allegation is that Plaintiff has shipped some of its products not covered by Patent No. 2,869,184 in cartons bearing this patent number which practice Defendant alleges constitutes a misuse of the patent and a violation of the anti-trust laws;

"b. That the substance of Plaintiff's response to the motion is that to the extent that such products not covered by Patent No. 2,869,184 were shipped in cartons bearing such patent number, such practice resulted from errors occurring in Plaintiff's shipping department wherein cartons bearing the patent number were inadvertently selected for packaging products not covered by the patent;

"c. That promptly upon being notified of such errors in Plaintiff's shipping department, Plaintiff took steps to insure that Patent No. 2,869,184 was removed from all cartons leaving Plaintiff's factory;

"d. That Defendant has not suggested any evidence to establish that the inclusion of Plaintiff's patent number on cartons not containing products covered by the patent was intended to deceive the public or to achieve a monopoly on unpatented combination sash balance and weatherstrip units or any non-patented products made by Plaintiff, and there is no evidence that the public was actually deceived or affected in any way by Plaintiff's inadvertent incorrect use of its patent number."

The Court of Appeals summarized these findings and stated (289 F.2d 772):

> "Under these circumstances we cannot rule that the denial of defendant's motion for partial new trial constituted an abuse of the District Court's discretion."

It thus appears that Question 1 presents no issue for consideration by this Court because:

(a) The Court of Appeals in its opinion did not even consider the question, and certainly did not hold that the Patent Act of July 19, 1952 overruled earlier decisions of this Court with respect to misuse and

(b) The findings of fact of the trial court affirmed by the Court of Appeals, establish that, as a matter of fact, there was no misuse.

QUESTION 2

At the time the application for the patent in suit was under preparation, it was at first thought that Raymond Zegers was the inventor, but at the suggestion of Respondent's patent counsel, a more thorough examination of the facts was undertaken and it was then concluded that William Zegers, rather than Raymond Zegers, was the inventor of the specific devices illustrated and described in the patent application which had then been prepared. The application was then filed in the name of William Zegers.

In the trial court Petitioner urged that the invention was actually the joint invention of Raymond Zegers and William Zegers and that because Respondent permitted the patent to issue in the name of William Zegers, Sec. 256, Title 35, USC could not be used by Petitioner to

correct the alleged error by adding the name of the alleged joint inventor to the issued patent. The whole matter of the applicability or non-applicability of Section 256 is dependent upon a finding that there was in fact a joint invention of the subject matter of the patent. With respect to this matter, Petitioner (Petition, Page 13), states:

> "The conclusion of the Court of Appeals that this was not a joint invention is an erroneous conclusion, which is contrary to the established test of joint inventions."

Thus, it is obvious that Question 2 suggested to this Court for its consideration, is predicated upon a concomitant reversal of the finding of fact that the invention was solely that of William H. Zegers.

On this matter of joint or sole invention, the trial court found (App. 385):

> "Defendant asserts that Raymond Zegers participated in the invention of the patent in suit, but the evidence establishes that Raymond Zegers had the broad idea of the desirability of a readily removable sash balance and weatherstrip unit, but that William H. Zegers, the inventor named in the patent in suit, actually invented the form of clip described and claimed in the patent in suit. I therefore find that Defendant's asserted defense relative to the participation of Raymond Zegers in the invention of the patent in suit is not sustained by the evidence."

On the same matter, the Court of Appeals stated (299 F.2d 769, 771):

> "The testimony indicates that application for the patent in suit was initially prepared in the name of Raymond Zegers; that after consideration of the facts

in the light of advice of patent counsel, it was determined that Raymond Zegers had urged the need for ready removability and had suggested one method which involved use of nails, but which had proved unsuccessful; that William H. Zegers had independently conceived the device shown in the patent application. Raymond Zegers himself was one of the witnesses who testified to that effect at the trial. Application was therefore made in William H. Zegers' name. The evidence supported the Trial Judge's finding that William H. Zegers was the actual inventor. There was no showing of a joint invention."

Since the District Court found as a fact that the invention was the sole invention of William Zegers, the patentee of the patent in suit, and since the Court of Appeals reviewed the evidence and concluded there was no showing of joint invention, the Court of Appeals did not reach the question as to whether Sec. 256 Title 35 was applicable, and certainly did not hold that the Patent Act of July 19, 1952 changed the law with respect to sole or joint inventors. There is no reference in the opinion of the Court of Appeals to the subject matter of this question.

CONCLUSION.

For the foregoing reasons, it appears that both questions suggested to this Court for consideration present subjects neither determined nor considered by the Court of Appeals and both questions inherently involve an application to this Court to reverse the fact findings of the trial court, which findings were considered and approved by the Court of Appeals.

It is suggested therefore, that the Petition For A Writ Of Certiorari be denied.

Respectfully submitted,

THOMAS F. MCWILLIAMS
53 West Jackson Blvd.
Chicago 3, Illinois
Attorney for Respondent